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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,502	11/11/2005	Werner Ertle	1431.124.101/	1444
25281 7590 10/08/2010 DICKE, BILLIG & CZAJA FIFTH STREET TOWERS 100 SOUTH FIFTH STREET, SUITE 2250 MINNEAPOLIS, MN 55402				
EXAMINER HUBER, ROBERT T				
ART UNIT 2892		PAPER NUMBER		
MAIL DATE 10/08/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/522,502	Applicant(s) ERTLE ET AL.
Examiner ROBERT HUBER	Art Unit 2892

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 18, 19, 22-33, 38, 39 and 41-44.
Claim(s) withdrawn from consideration: 34-37.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Thao X Le/
Supervisory Patent Examiner, Art Unit 2892

Continuation of 11, does NOT place the application in condition for allowance because: The Applicant argues that the Examiner's interpretation of the areas 56a and 56b to be the test areas and contact areas, respectively, is not taught by Kim, and that Kim teaches the opposite relationship that areas 56a and 56b are contact areas and test areas, respectively. The Examiner acknowledges that Kim discloses in col. 4, lines 1-4 that the test areas are indicated as 56b. However, the recitation of a "contact" area and a "test" area are statements of intended use, since they are indicating that the areas are intended to be used as a "contact" area and a "test" area. The Examiner submits that both areas 56a and 56b may be used as either a "test" area or a "contact" area since they both connect to the underlying structure, and are able to provide both testing and contact to the underlying structure. Hence, the Examiner maintains that the interpretation of the "test" area and "contact" to be areas 56a and 56b is valid. It has been held by the courts that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham 2 USPQ2d 1647 (1987). See MPEP 2114.

The Applicant also argues that the combination of the sealing of the test areas of Takemae with the device of Kim would render the device of Kim inoperable. The Examiner respectfully disagrees. The Examiner submits that if "test" areas 56a were sealed, as rendered obvious by Takemae, that that device of Kim will still operate, since sealing the areas 56a of Kim will not alter the underlying structure. Whether or not the device is intended to be connected to an external circuit is a matter of intended use. One of ordinary skill in the art will recognize that the areas may be sealed to prevent further contamination, or they may be sealed and then again unsealed if one of ordinary skill in the art intends to connect them to an external device in the future. The Examiner maintains that Kim in view of Takemae renders obvious the STRUCTURE, and that the intended use of the structure is not germane to the claimed structure limitations, as per MPEP 2114.

The Applicant also argues that Kim teaches away from sealing the test areas by stating that Kim discloses cutting the wafer such that areas 56b are cut away. The Examiner acknowledges that Kim teaches the cutting away of areas 56b, however, Kim does not disclose anywhere that areas 56a (which the examiner interprets as the test areas) cannot be sealed. Furthermore, the Examiner submits that sealing the areas 56a is rendered obvious by Takemae, with at least the purpose of protecting the areas from contamination. The Examiner submits that Kim does not teach away from sealing the areas 56a or 56b.

Furthermore, the Examiner notes that figure 5 of Kim is very similar to figure 2 of the current application, and that the difference seems to be only the use of the areas 1 and 2 of figure 2 of the current application as "contact" and "test" areas, respectively, which is the opposite relationship as disclosed by Kim. The Examiner submits that Kim in view of Strauss and Takemae disclose the structure, and that the use of the areas as "contact" areas and "test" areas is merely a statement of intended use, and that one of ordinary skill in the art will recognize that one may use either as a "test" area or a "contact" area.

Still further, the claims recite a "passive region" and an "active region" on the chip, that the contact areas are on the passive region, and the test areas are on the active region. The Examiner notes that the term "region" is a term of broad scope, and that any area or section of the device may be interpreted as a "region". For example, in figure 5 of Kim, the entire region 34 may be interpreted as an "active" region since there are elements of active components within this region (e.g. p-well in an n-substrate, which may be considered a p-n junction diode) and that the "passive" region may be considered simply the top of layer 53, since layer 53 is an insulating layer. Hence, one may reinterpret in Kim the "contact" areas as areas 56a on "passive" region of layer 53, and the "test" areas as areas 56b on an "active" region 34. With such an interpretation, Kim in view of Strauss and Takemae still renders obvious the claimed invention, the rejections are still maintained, and the arguments presented in amendment filed 24 September 2010 are rendered moot..